

Application Serial No. 09/896,653
Amendment Dated March 21, 2005
Reply to Office Action of September 21, 2004

REMARKS/ARGUMENTS

Reconsideration of the rejection is respectfully requested in view of the foregoing amendments, and the following comments.

Claims 1-44 are pending in the present application, prior to entry of this amendment as set forth above. Claims 1, 13, 25, 36, and 44, are independent. Claims 1, 13, 25, 36, and 44 have been amended to address the rejections.

With the foregoing in mind, the Examiner's attention is respectfully now directed to the following specific comments regarding the rejections, the claims, and the amendments made herein.

Claim Rejections – 35 USC § 102(e)

Claims 1, 3-13, 15-24, 27-32 and 38-43 were rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 6,657,702 to *Chui et al.* With regard to independent claims 1 and 25, the Examiner indicated that *Chui* discloses a method for processing and printing electronic images on a medium comprising steps of: a) receiving an electronic image file; b) associating identification information with the electronic image file; c) generating a composite image file, wherein the composite image file includes the electronic image file and the identification information; d) printing the composite image from the composite image file on a medium, the composite image including an image and a first symbol, the first symbol including the identification information; e) extracting the identification information from the first symbol; and f) printing the identification information read from the first symbol on the medium.

(Note: the Examiner's remarks above in the Office Action were indicated as applicable to claims 1 and 25, but it is believed that the Examiner meant to direct the remarks to claim 13.)

With regard to independent claim 13, the Examiner indicated that *Chui* discloses a method for processing and printing electronic images on a medium comprising the step of: a) receiving an electronic image file; b) associating identification information with the electronic

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image file; c) generating a composite image file, wherein the composite image file includes the electronic image file and the identification information; d) printing the composite image from the composite image file on a medium, the composite image including an image and a first symbol, the first symbol including the identification information; e) extracting the identification information from the first symbol; f) printing the identification information read from the first symbol on the medium; and g) separating the first symbol from the medium for the composite image.

This rejection is respectfully traversed. For reasons that will be shown, independent claims 1 and 13 are not anticipated by the *Chui* patent.

Summary of the Present Invention

The present invention pertains to systems for printing electronic images, in particular photographic images. More particularly, the inventive aspects relate to the manner in which a symbol (e.g. containing identification information, an annotation, etc.) relating to each image are printed (e.g. as a bar code) on the same side of the medium as the image itself, associated with that particular image. This symbol is read from the front or first side of the medium, typically in a later processing step, and used to print other information such as identification information, an annotation, etc. on the reverse side (backprinting). Among other things, this allows high speed printing and processing of the medium, for example on continuous rolls, followed by later backprinting of the other information on the reverse side. As will be shown, these aspects are not disclosed, taught, or suggested by either the *Chui* patent or the *Redd* patent, taken singularly or in combination.

In general, the independent claims have been amended to recite aspects relating to the printing of a symbol or other information on one surface of a medium, typically adjacent or proximate to the picture or image itself, with this symbol or information being read, typically later in the processing of the images, and information printed on a second surface of the medium (e.g. the back) that is derived from the reading of the information from the front. Support for the amendments to the claims is clearly seen in FIG. 3 and the accompanying text; FIG. 4 and

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associated text; and FIG. 13, steps 530 (composite image), 540 (scan first barcode), and 560 (print annotation and second barcode on image reverse).

Although amendments in general along these lines have been made, no admission is made that the foregoing generalization necessarily applies to each amended claim; the amendments to each claim are separate and should be considered separately and independently.

Comments Regarding Specific Claims

Claims 1 and 13 of the application have been amended to emphasize certain novel features of the inventions, as described. Claim 1, as amended, of this application relates to a method for processing and printing electronic images on a medium. The method comprises various steps including: a) receiving an electronic image file; b) associating identification information with the electronic image file; c) generating a composite image file, wherein the composite image file includes the electronic image file and the identification information; d) printing the composite image from the composite image file on a first surface of a medium, the composite image including an image and a first symbol, the first symbol including the identification information; e) extracting the identification information from the first symbol; and f) printing the identification information read from the first symbol on a second surface of the medium. (Emphasis supplied, not necessarily corresponding to the amendments.)

It is very apparent that the *Chui* patent provides no teachings whatsoever about printing a composite image file, symbol or any information on the front side of a medium, including a symbol, that is read and used for later backprinting or other processing. The *Chui* patent relates to a method for facilitating the re-ordering of photographic prints. The portions of *Chui* cited by the Examiner have no relevance to what side information is printed on. Admittedly, *Chui* teaches the backprinting of information, but it says nothing about the source of that information being from a symbol or other information derived from the front of the same image.

For example, col. 14, lines 14-19, describes the nature of the backprinted information in *Chui*: "With regard to the former (ordering additional prints), each print could be encoded on its back or front with a print re-order number that uniquely identifies the print, the image used to

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create the print, the particular recipient of the print, and/or the originator of the print/image." But this passage says absolutely nothing about how to encode a print on the front, or the back, to facilitate reordering; the reader is left to assume that the re-order number is generated from within the system. There is nothing to suggest that the re-order information would or could be derived from a symbol on the front of the same image. Thus, *Chui* does not disclose, teach, or suggest that a composite image containing the picture and a symbol are printed on one side of a medium, and that the symbol is read and the information used to print something on the reverse side.

Accordingly, claim 1, as amended, is not anticipated by *Chui*.

A similar observation may be made with respect to independent claim 13. Claim 13, as amended, is directed to a method for processing and printing electronic images on a medium. The method comprises the steps of: a) receiving an electronic image file; b) associating identification information with the electronic image file; c) generating a composite image file, wherein the composite image file includes the electronic image file and the identification information; d) printing the composite image from the composite image file on a first surface of a medium, the composite image including an image and a first symbol, the first symbol including the identification information; e) extracting the identification information from the first symbol by reading the first symbol from the first surface of the medium; f) printing the identification information read from the first symbol on a second surface of the medium; and g) separating the first symbol from the medium for the composite image. (Emphasis supplied, not necessarily corresponding to the amendments.)

For the same reasons as mentioned above in connection with claim 1, it is submitted that these aspects are not disclosed, taught, or suggested by *Chui*. Accordingly, claim 13 is not anticipated.

Claims 25, 33-36 and 44 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,646,754 to *Redd et al.* With regard to claim 25, the Examiner asserted that *Redd* discloses an annotation printer apparatus (print lab 600) for processing images on a medium and printing information thereon comprising: a) means (barcode reader 633, 636) for

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reading a plurality of first symbols existing on the medium, wherein each of the first symbols corresponds to one of a plurality of images existing on the medium, the first symbol including identification information; b) means (printer 622, backprinter 634) for printing identification information read from each of the first symbols, wherein the identification information read from each of the first symbols is printed proximate to the image and first symbol to which it correspond; and c) means (scheduler 608) for regulating movement of the medium through the apparatus to coordinate the reading of each first symbol and the printing of each second symbol.

Redd also does not disclose, teach, or suggest that any symbols or identification information are printed on a first side of a medium, then read and used to print information on the back or reverse side of medium, to facilitate the processing of images. The *Redd* patent relates to backprinting of image prints. But *Redd*, like *Chui*, does not describe or suggest that information printed on the front of each image can be used to obtain information that is printed on the back or reverse side of an image. Indeed, the mechanism used in *Redd* for carrying information for a group of images or prints – a “destination identifier print” – clearly teaches away from the methods and apparatus of the present invention.

Consider in particular FIG. 7 of *Redd*, which illustrates a destination identifier print. Col. 12, lines 7-15 of *Redd* describes the function of this destination identifier print: “Typically each run of prints (corresponding to a separate sub-order) is preceded (or followed) by a destination identifier, for example, a print that includes the name and address of the intended recipient for the run under consideration. This destination identifier separates adjacent runs and provides a convenient delimiter and/or address label to allow the distribution system 350 to package up runs of prints quickly and efficiently and to initiate delivery of them to their respective intended recipients.” (Emphasis supplied.)

Col. 17, lines 10-25, of *Redd* provides more information about the destination identifier print. This description read, in pertinent part, as follows: “An example of a destination identifier print 900 (which is printed from a destination identifier image that is created and inserted into a sub-batch) is shown in FIG. 7. A destination identifier image from which the destination identifier print 900 can be printed can include data for generating one or more of the following: a

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message 902 (e.g., a user-specified message or advertisement), thumbnail index 903 including thumbnail images 509, 511, 513, and 516-518 of the images included in the sub-batch, reordering information 908, bar code 910 (encoding, for example, shipping or billing information and/or manufacturing process information used to maintain quality control during print generation), and an address field 906 displaying the recipient's address. ... In other embodiments, the destination identifier 900 can include virtually any other items of information that might prove useful to the recipient, the fulfillment enterprise, and/or the delivery service. Although the foregoing describes the destination identifier image as being created after the batches have been assembled, it is to be understood that the destination identifier images can be created any time prior to printing. For example, the destination identifier images can be created after the sub-orders are sub-divided into sub-batches."

It is readily apparent from *Redd* that (1) a separate "destination identifier print", which is a separately printed image containing information about a batch of pictures, is provided to carry information about the pictures, and (2) with this approach to carrying information about a batch and separating batches, there is no reason or need to print information on one side of the medium, for each image, including a symbol or identifier, from which information for the back side is obtained.

Claim 25 has been amended to emphasize these distinctions. Claim 25 relates to an annotation printer apparatus for processing images on a medium and printing information thereon. The claimed printer comprises a) means for reading a plurality of first symbols existing on a first surface of the medium, wherein each of the first symbols corresponds to one of a plurality of images existing on the medium, the first symbol including identification information; b) means for printing identification information read from each of the first symbols on a second surface of the medium (e.g. by backprinting), wherein the identification information read from each of the first symbols is printed on the reverse side of the image and first symbol to which it corresponds; and c) means for regulating movement of the medium through the apparatus to coordinate the reading of each first symbol and the printing of the identification information. (Emphasis supplied, not necessarily corresponding to the amendments.)

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From the foregoing, it should be readily apparent that *Redd* does not disclose, teach, or suggest these features. Claim 25, as amended, is therefore not anticipated.

Similar observations can be made with respect to claims 36 and 44, as amended. These claims have been amended in a manner similar to the other independent claims to highlight the differences between the claimed subject matter and the *Redd* patent.

For example, claim 36 is directed to an annotation printer apparatus for processing images on a medium and printing information thereon. The claim now recites a means for reading a plurality of first symbols existing on a first surface of the medium, wherein each of the first symbols is on the same surface as, proximate to and corresponds to one of a plurality of images existing on the medium.

Similarly, claim 44 is directed to a photo-shop for processing and printing digital images. The claim recites a photographic printer for printing photographic composite images on a first surface of a medium, each of the composite images including an image portion and a first symbol. The claim further recites an annotation printer apparatus including means for reading a first symbol existing on the first surface of the medium, wherein the first symbol corresponds to one of a plurality of images existing on the medium.

Because the *Redd* patent does not disclose, teach, or suggest these features, claims 36 and 44 are not anticipated.

Claim Rejections – 35 U.S.C. § 103

Claims 2, 14, 26, and 37 were rejected under 35 U.S.C. § 103 as unpatentable over *Chui* in view of *Redd*. The Examiner indicated that *Chui* also discloses wherein the medium is printed, but does not clearly teach that the medium is a continuous roll of photographic paper. *Redd* was cited as disclosing a system for backprinting image prints where the medium is a continuous roll of photographic paper. The Examiner concluded it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified *Chui* to include the print medium being a continuous roll of photographic paper as taught by *Redd*. The examiner

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further asserted that it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified *Chui* by the teaching of *Redd* to allow successive printing onto successive portions of a roll of print paper as taught by *Redd*.

All of these claims are dependent claims. Under the doctrine of *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988), if an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. As clearly illustrated above in connection with the rejections under 35 U.S.C. § 102, there is no disclosure, teaching, or suggestion in either *Chui* or *Redd*, taken singularly or in combination, of an invention that involves (for example, as in claim 1, as amended) printing a composite image including an image and a first symbol (the first symbol including identification information or other information) on a first surface of a medium, extracting or reading the information from the first symbol, and printing the information read from the first symbol on a second surface of the medium. Accordingly, the independent claims are not anticipated and not obvious from the references, the corresponding and associated dependent claims should also be patentable.

Conclusion

For the foregoing reasons, it is respectfully submitted that independent claims 1, 13, 25, 36, and 44, as amended, and the remaining dependent claims, are novel and are non-obvious in view of the references and should be allowable.

The foregoing is presented as a full and complete response to the Office Action mailed September 21, 2004, and is believed to have placed all claims in condition for allowance. Such action is courteously solicited. If any issues remain that can be resolved by telephone, the Examiner is respectfully requested to contact the undersigned at 404-233-7000.

Applicant submits this Amendment and Response to First Office Action with a Request for a three-month Extension of Time in which to file. A PTO-2038 Credit Card Payment Form is transmitted herewith authorizing payment in the amount of \$510.00 (small entity) for a three-

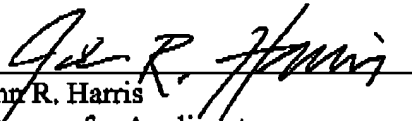
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month extension of time. Applicant respectfully requests that the Office notify the undersigned if there are any additional fees due that have not been identified or included herewith.

It is now believed that the application is in condition for allowance and such allowance is respectfully requested.

Respectfully submitted,
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